

HW#8
3-1-99
Election
Patent

Attorney's Docket No. 011495-031

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Roger R. BELANGER

Application No.: 09/013,930

Filed: January 27, 1998

For: FOLDING APPARATUS FOR
ROTARY PRINTING PRESSES



Group Art Unit: 3725

Examiner: E. Ojini

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RESPONSE TO ELECTION OF SPECIES

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In an Official Action dated February 9, 1999, the Examiner has indicated that an election of one of the following inventions is required under 35 U.S.C. § 121:

Species I: Figures 1-3; and

Species II: Figures 4 and 5.

Accordingly, Applicant provisionally elects Group I, the subject matter illustrated in Figures 1-3, with traverse. Presently, claims 1-14 and 17-21 are generic and read on the elected species illustrated in Figures 1-3.

Applicants respectfully submit that the requirement for an election is in error. Because claims 1-14 and 17-21 are generic to the species identified by the Examiner, it is respectfully submitted that the election requirement is in error. The election requirement is traversed because it will not reduce the workload of the U.S. Patent and Trademark Office or simplify prosecution of the application.

Furthermore, upon allowance of a generic claim, Applicants are entitled to claims directed to a reasonable number of species. It is respectfully submitted that the non-elected species identified by the Examiner constitute a reasonable number. As set forth in

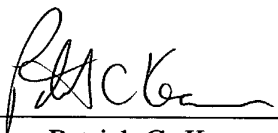
M.P.E.P. Section 803, there are two criteria for a proper restriction requirement between patentably distinct inventions: (1) the inventions must be independent or distinct as claimed; and (2) there must be a **serious burden** on the Examiner if restriction is not required. This portion of the M.P.E.P. requires that if the search and examination of an entire application can be made without serious burden, the Examiner **must** examine it on the merits, even though it includes claims to distinct or independent inventions.

Accordingly, withdrawal of the aforementioned species election is respectfully requested. The provisional election is hereby made without prejudice to Applicant's right to file a divisional application or applications should the election requirement become final.

Respectfully submitted,

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Date: March 2, 1999

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